

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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*Ex parte* NIGEL PINNELL

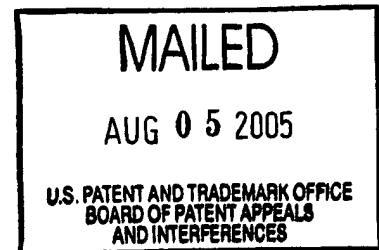
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Appeal No. 2005-0120  
Application No. 09/641,896

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ON BRIEF

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Before HAIRSTON, BARRY, and NAPPI, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

A patent examiner rejected claims 1-58. The appellant appeals therefrom under 35 U.S.C. § 134(a). We remand.

In an *ex parte* appeal, "the Board is basically a board of review — we review . . . rejections made by patent examiners." *Ex parte Gambogi*, 62 USPQ2d 1209, 1211 (Bd.Pat.App. & Int. 2001). Here, after considering the record, we are persuaded that "[t]he appeal is manifestly not ready for a decision on the merits." *Ex parte Braeken*, 54

USPQ2d 1110, 1112 (Bd.Pat.App. & Int. 1999). Our opinion addresses the following concerns:

- sole reliance on abstract
- listing of reference not applied.

### I. SOLE RELIANCE ON ABSTRACT

"Citation of an abstract without citation and reliance on the underlying scientific document itself is generally inappropriate where both the abstract and the underlying document are prior art." *Ex parte Jones*, 62 USPQ2d 1206, 1208 (Bd.Pat.App. & Int. 2001). "[A] proper examination under 37 CFR § 1.104 should be based on the underlying documents and translations, where needed. Accordingly, the preferred practice is for the examiner to cite and rely on the underlying document." *Id.* "To determine whether both the abstract and the underlying document are prior art, a copy of the underlying document must be obtained and analyzed." M.P.E.P. § 706.02 (8th ed., rev. 2, May 2004.)

Here, the examiner rejects claim 37 over a combination of references that includes "'Embedded SQL in RPG' by Cozzi." (Examiner's Answer at 14.) In doing so, he cites to an abstract of Cozzi, without relying on the underlying document itself. (*Id.*)

Rather than citing to the underlying document, "[t]he examiner **presumes** that the stored database record may contain any data, including a record of payment instrument details." (*Id.* at 14-15.) Furthermore, we find no copy of the underlying document in the record.

"The review authorized by 35 U.S.C. Section 134 is not a process whereby the examiner . . . invite[s] the [B]oard to examine the application and resolve patentability in the first instance." *Braeken*, 54 USPQ2d at 1112. Accordingly, a copy of the underlying document is needed for our review of the rejection. Furthermore, the examiner should base his rejection on the document, citing thereto.

## II. LISTING OF REFERENCE NOT APPLIED

An "examiner's answer is required to include . . . [a] listing of the references of record relied on. . . ." M.P.E.P. § 1208. Here, the *Prior Art of Record* section of the examiner's answer lists "GB 2333878" to "SLATER." (Examiner's Answer at 3.) The remainder of the answer, however, does not mention, let alone apply, Slater in a rejection. We decline to substitute speculation about that status of the Slater reference. Instead, the examiner should clarify the status of the reference.

### III. CONCLUSION

For the aforementioned reasons, the application is remanded to the examiner to prepare a substitute examiner's answer correcting the aforementioned deficiencies. The substitute answer should be self-contained with respect to all rejections and arguments; no prior examiner's answer or Office action should be referenced or incorporated therein. Similarly, any brief submitted by the appellant should be self-contained with respect to all arguments; no prior brief should be referenced or incorporated therein.

Because it is being remanded for further action, the application is a "special" application. M.P.E.P. § 708.01(D). Accordingly, it requires immediate action. Furthermore, the Board should be informed promptly of any action affecting status of the appeal (e.g., abandonment, issue, reopening prosecution).

**KENNETH W. HAIRSTON**  
Administrative Patent Judge

BOARD OF PATENT  
APPEALS  
AND  
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~~ROBERT E. NAPPI~~  
Administrative Patent Judge

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